

REMARKS

Claims 27-40 are pending in the application. Claims 27, 28, 33, 35, and 36 are rejected under 35 USC 103(a) as being unpatentable over US patent 6,151,609 (Truong) in view of US patent 7,054,952 (Schwerdtfeger et al.) and US patent 5,737,523 (Callaghan et al.). Claims 29-32 and 37-40 were rejected under 35 USC 103(a) as being unpatentable over Truong in view of Schwerdtfeger, Callaghan, and US patent publication 2003/0195886 (Vishlitzky). Claim 34 was rejected under 35 USC 103(a) as being unpatentable over Truong in view of Schwerdtfeger, Callaghan, and WO 2002-095954 (Lee).

Claims 27, 28, 33, 35, and 36 are amended herein. Claims 41 and 42 are new. No new matter is added. Claims 27-42 are presented for examination.

Description of claim amendments

Claim 27 is amended to recite "for engineering" per abstract line 2 and par. 14, lines 4-6.

Amendments to claims 27 and 33, and new claims 41 and 42, clarify the distinction between the "first" and "second" file formats. The fundamental difference described the specification is that the first format cannot be processed by the Web browser in the client, and the second format can be processed by the Web browser. This is especially supported in paragraphs 16 and 19-22. The first format is called "special file format" in par. 24, lines 10-11. This means it is specialized to being processed by the engineering server, and is not a format that can be processed by the Web browser. In particular it is not HTML, XML, DHTML, SVG, or JavaScript as recited in new claims 41 and 42.

Response to rejections under 35 USC 103

1) Regarding claim 27: Examiner cites Truong's server 15 with memory 46 and mass storage 44, but does not identify client-editable files for engineering an automation system as claimed. FIG 4 of Truong shows a listing of files for editing. These are html files, and can thus be processed by a browser. They will take branch 154 in the flowchart of FIG 3C. No

format conversion of these files is needed, since they are stored on the server as html. They are not described as files for engineering an automation system. They appear to be human-interaction files, including welcome.html, whatsnew.htm, survey.htm, etc.

Examiner cites a "first format" in Truong (Office Action p. 3 line 15, and p. 4 line 10) and a "second format" (p. 4 line 1). However, Truong only shows one format for editable files, which is html, whether in server storage, transmission, or client editing. Examiner concedes that Truong does not teach converting received files into a first format, but Truong also does not teach converting from a first to a second format. There is no need for format conversion in either direction in Truong, so there is no implied suggestion for it.

Examiner cites col. 7, lines 34-40 as teaching files in a first format for configuration of an automation system. The relevant lines of Truong are: "*Operating system 38 and remote editor program 40 are stored in mass storage device 44 and are shown loaded into server memory 46.*" However, elements 38 and 40 are not the files that are transmitted to the client 4 for editing. They are computer programs. If a computer program module 38 or 40 were selected for editing in Truong, it would take branch 152 of FIG 3C, and produce an error message. There is no function or suggestion in Truong to convert such files to html files.

Examiner has not identified any files on the Truong server in a first format that could be beneficially converted to a second format for transmission to a client. Converting any editable file shown in Truong from html to another format would make it incompatible with a browser, making Truong inoperable.

KSR v Teleflex 550 U.S. ____ (2007) Syllabus I. (b): The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does. Inventions usually rely upon building blocks long since uncovered, and claimed discoveries almost necessarily will be combinations of what, in some sense, is already known.

MPEP 2143.01 V. THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

MPEP 2143.01 VI. THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

Examiner cites Schwerdtfeger as teaching converting the received files into the first format. But the first format of Schwerdtfeger is HTML, XML, or JavaScript, and the second format is an original script based on a document object model (abstract and throughout). A transcoder proxy 28 formats and transmits limited portions of the original script to the client 22, and executes JavaScript elements 70 on behalf of the client. This is nothing like the claimed invention. The first format of Schwerdtfeger can be processed by a Web browser, so it cannot be the first format claimed herein. In Truong, there is no need to convert his server files, which are in HTML or XML, to a second format for a client browser, so there is no motivation for this proposed combination. In any case, it would not produce the claimed invention.

Examiner motivates a combination of Truong and Schwerdtfeger as follows:

- a) To provide access to files by a client in a first format. However, this is not claimed. The claimed "first format" is the specialized file format on Applicant's server 1. The invention provides access to files by a client in a second format that is compatible with a Web browser. The "first" and "second" formats are clarified by amendments herein.
- b) To translate a document from one file format to a script expressed into a second format. This is a conclusory statement that a format conversion could be done, not a motivation. Why would this be done if the file is already in a browser-compatible format?
- c) Examiner asserts "In addition it supplies a description of the elements within some portion of a particular document and includes identifiers assigned to the elements within some portion of the document". However, this is not claimed, and is unrelated to the invention.

2) Callaghan does not address the above failures of Truong and Schwerdtfeger. Furthermore, Examiner's motivation for combining Callaghan with Truong and Schwerdtfeger is to conserve RAM on the server by offloading file modification resources onto the client, but this is opposite to the purpose of Schwerdtfeger, which is to conserve resources on the client.

3) Regarding claim 28: Truong FIGs 3A and 3B teach sending a password to a server (step 118), validating the password (steps 130, 132), and rejecting a client not authorized to use the system (steps 132, 134). This is a system level authorization. The phrase "specific selection of files" or equivalent is not found in Truong. This phrase is taken from Applicant's claim and specification (par. 33, line 8). Claim 28 recites authorizing specific files to specific clients as supported in Applicant's paragraphs 32-33. This claim is not met by a system level authorization such as in Truong.

4) Regarding claims 33 and 34: The above arguments regarding claim 27 also apply to claims 33 and 34. Examiner cites the first digital format as corresponding to HTML or XML of Schwerdtfeger. This does not meet the claims, as argued regarding claim 27.

At bottom of page 5 of the Office Action, Examiner cites a passage from Truong, but attributes it to Schwerdtfeger. On page 6, lines 19-23 of the Office Action, Examiner cites a passage, but does not identify the reference. This occurs elsewhere as well -- for example on page 7, lines 4-8 of the Office Action. Applicant requests that the reference of each cited passage be identified so that the cited passages can be studied in context.

5) Regarding claim 35: Examiner does not identify an access management element that only allows access to a file by one client. Examiner cites a transcoder proxy and a PDA of Schwerdtfeger, but does not indicate how either of these elements prevents access to a file by multiple clients. Without access management, multiple PDAs could use the same or multiple transcoder proxies on the same file at the same time.

Examiner cites Schwerdtfeger col. 3, lines 13-52, which include: "*The model may also define methods for accessing and manipulating the document. The model may be, for example, a document object model DOM.*" However, none of lines 13-52 mention limiting access to one of several clients as claimed. It is unclear how the cited lines were intended to support the rejection. Schwerdtfeger does not mention anything about client authorization, security, or limiting of access.

6) Regarding claim 36: Examiner cites Callaghan and Truong, but both of these references provide only system level authorization -- not individual file authorization as claimed. Callaghan only teaches mounting and authorization of a "file system" to a client.

Examiner cites Callaghan col. 10, lines 9-12 regarding keeping a log of which of the clients is accessing which of the files. However, this is not found. The cited lines only describe maintaining a record of unauthenticated client requests. This is not a log of which of the clients is accessing which of the files. Furthermore, they do not describe providing conflict resolution when more than one client simultaneously requests access to a specific file.

Truong FIGs 3A and 3B teach sending a password to a server (step 118), validating the password (steps 130, 132), and rejecting a client not authorized to use the system (steps 132, 134). However, this is system level authorization. The phrase "specific selection of files" or equivalent is not found in Truong. This is a phrase taken from Applicant's claim and specification (par. 33, line 8). Claim 36 recites authorizing specific files to specific clients.

Truong step 118 is silent as to authorizing a given client to access a given selection of files. Instead it grants a client access to a server. Truong, col. 7, lines 17-19: "*The login ID, password, and remote server path inputs identify a particular user and whether the user has access rights to remote Internet server 15.*"

7) Regarding claims 29-32 and 37-40: Vishlitzky does not supply the missing elements of the respective parent claims as argued above.

8) Regarding claims 31 and 39: Examiner cites Vishlitzky par. 48, which describes a process of testing a pair of resource locks to see if the resource is available, if so, reserving the resource, if not, releasing the locks. However, a later requesting process does not notify an earlier process with current access that the later requesting process is requesting access. Thus, it does not meet these claims.

Paragraph 48 of Vishlitzky describes device information tables that map available cylinders and tracks on a disk. Clients are not listed in these tables, and the listed devices, cylinders, and tracks are not selected by their listed order in the table. The tables represent direct access storage. Cylinders and tracks are selected randomly, not sequentially, in order to copy only the tracks needed by a process at a given time into virtual storage, rather than a whole volume. This does not relate to assigning different access priorities for different clients, such that a later requesting client may override an earlier requesting client, and it does not meet the claim.

9) Regarding claim 40: Examiner cites Vishlitzky par. 49, which describes a process of locating and locking a track before using it. No notification to an earlier requesting process with current access is made by a later requesting process that access is being requested, so this does not meet the claim.

10) Lee does not address the deficiencies of Truong, Schwerdtfeger, and Callaghan as argued above.

Conclusion

M.P.E.P. 2143.03 provides that to establish prima facie obviousness of a claimed invention, all words in a claim must be considered in judging the patentability of that claim against the prior art. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.

As argued above, the proposed combinations are not motivated and do not produce the invention as claimed, so they do not support the obviousness rejections. This application is in condition for allowance, which is respectfully requested.

The commissioner is hereby authorized to charge any appropriate fees due in connection with this paper, including the fees specified in 37 C.F.R. §§ 1.16 (c), 1.17(a)(1) and 1.20(d), or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

Dated:

Dec. 1, 2009

By:

Janet D. Hood

Janet D. Hood
Registration No. 61,142
(407) 736-4234

Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, New Jersey 08830